No. 228

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In the Supreme Court of the United States

OCTOBER TERM, 1969

TRI-WALL CONTAINERS, INC., PETITIONER

v.

UNITED STATES OF AMERICA

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

MEMORANDUM FOR THE UNITED STATES IN OPPOSITION

ERWIN N. GRISWOLD,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

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Petitioner instituted this action in the Court of Claims, seeking to recover compensation from the United States under 28 U.S.C. 1498 for the alleged infringement of claims 1, 2 and 3 of its U.S. Patent No. 3,096,224, covering a machine-made triple wall corrugated paper board product used as a packaging material. The Court of Claims entered judgment for the United States, adopting the findings and conclusion of the Trial Commissioner that the patent was invalid under 35 U.S.C. 102(b), which renders

non-patentable those inventions which were "in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States".

Petitioner conceded that more than a year prior to its patent application it had sold for public use a triple wall corrugated paper board product which it had produced by a manual process. Petitioner contended, however, that the machine-made product is patentably distinguishable from the product of the manual process because it possesses wood-like characteristics, while the manually laminated product has very few desirable qualities for a container (Pet. App. 4a). The Trial Commissioner found that this assertion was not supported by the evidence and that, on the contrary, the evidence introduced by the government established the "substantial identity of the product of the asserted patent claims and the manually produced item [previously] sold by [petitioner] * * *" (*ibid.*). The Commissioner summarized his findings and conclusions as follows:

> The product of the asserted patent claims is structurally indistinguishable from carefully manufactured triple wall board made according to [petitioner's] manual method. Any difference in strength which might exist between these two products results from the greater uniformity and efficiency which can be achieved by machine (double backer) manufacture. The actions of the [petitioner's] officers and agents during the period 1952-1953 show that the manually produced product was asserted to have the same desirable properties which [petitioner] now uses as

a basis for arguing patentability of the wall board claim in the '224 patent. It is concluded that the *product* defined in the asserted patent claims is not patentably distinguishable from the *product* of the prior manual process.[1]

Petitioner seeks further review in this Court of the purely factual, and amply supported, determination of the court below that there was substantial identity between the patented product and the manually produced product which admittedly had been in prior use. The petition raises no issue of general importance in the administration of the patent laws, and there is no conflict in decisions.

It is therefore respectfully submitted that the petition for a writ of certiorari should be denied.

ERWIN N. GRISWOLD,
Solicitor General.

JULY 1969.

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[1] *Ibid.* In this connection, the Commissioner referred to the settled principle that a "product claimed as made by a new process is not patentable unless the product is new. *The Wood-Paper Patent*, 90 U.S. (23 Wall.) 566, 596 (1874); *Cochrane* v. *Badische Anilin & Soda Fabrik*, 111 U.S. 293, 311 (1884)."

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